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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,589	01/08/2001	Deger C. Tunc	Osteonics 3.0-094 DIV 5632	
530	7590 05/29/2003			
LERNER, DAVID, LITTENBERG,			EXAMINER	
600 SOUTH A	& MENTLIK AVENUE WEST		TRUONG, DUC	
WESTFIELD, NJ 07090			ART UNIT	PAPER NUMBER
			1731	C
			DATE MAILED: 05/29/2003	7

Please find below and/or attached an Office communication concerning this application or proceeding.

		mk-l			
	Application No.	Applicant(s)			
00000 40400 00000000	09/756,589	TUNC, DEGER C.			
Office Action Summary	Examiner	Art Unit			
	Duc Truong	1711			
Th MAILING DATE of this communication app ars on the cover sheet with the correspondence address Period for Reply					
A SHORTENED STATUTORY PERIOD FOR REPLY THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a reply If NO period for reply is specified above, the maximum statutory period w Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).  Status	66(a). In no event, however, may a reply be time within the statutory minimum of thirty (30) days fill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	nely filed s will be considered timely. the mailing date of this communication. D (35 U.S.C. § 133).			
1) Responsive to communication(s) filed on	•				
2a)  This action is <b>FINAL</b> . 2b)  Thi	s action is non-final.				
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.					
Disposition of Claims	Ex parte Quayle, 1933 C.D. 11, 4	.55 O.G. 215.			
4) Claim(s) 34-66 is/are pending in the applicatio	n.				
4a) Of the above claim(s) is/are withdraw	vn from consideration.				
5) Claim(s) is/are allowed.					
6)⊠ Claim(s) <u>34-66</u> is/are rejected.					
7) Claim(s) is/are objected to.					
8) Claim(s) are subject to restriction and/or	r election requirement.				
Application Papers					
9) The specification is objected to by the Examiner.					
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).					
11) The proposed drawing correction filed on is: a) approved b) disapproved by the Examiner.					
If approved, corrected drawings are required in reply to this Office action.					
12) The oath or declaration is objected to by the Examiner.					
Priority under 35 U.S.C. §§ 119 and 120					
13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).					
a) ☐ All b) ☐ Some * c) ☐ None of:					
<ol> <li>Certified copies of the priority documents</li> </ol>	s have been received.				
2. Certified copies of the priority documents have been received in Application No					
<ul> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>* See the attached detailed Office action for a list of the certified copies not received.</li> </ul>					
14) Acknowledgment is made of a claim for domestic	c priority under 35 U.S.C. § 119(e	e) (to a provisional application).			
a) ☐ The translation of the foreign language provisional application has been received. 15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.					
Attachment(s)					
<ol> <li>Notice of References Cited (PTO-892)</li> <li>Notice of Draftsperson's Patent Drawing Review (PTO-948)</li> <li>Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.</li> </ol>	5) 🔲 Notice of Informal F	(PTO-413) Paper No(s) Patent Application (PTO-152)			

Application/Control Number: 09/756,589

Art Unit: 1711

## **DETAILED ACTION**

## Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 34-66 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,206,883. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences are claims 1-11 and 15-24 of the reference is the combination of the instant claims 34-41 and 45-54, the instant claims 42-44 and 45-are read on the combination of claims 12-14 and 17-21 of the reference, and claims 25-31 of the reference is the combination of the instant claims 55, 62-65 and 56-61.

Therefore, it would have been obvious to one of ordinary skill in the art to combine the claims of the reference to get the instant claims, for the reasons as stated above, since they have been shown to be effective in a similar system and thus would

Application/Control Number: 09/756,589

Art Unit: 1711

have been expected to provide adequate results. There is no showing of unexpected results derived from said use.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Truong whose telephone number is 703-308-2437. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703-308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

DT

May 27, 2003

DUCTRUONG PRIMARY EXAMINER